

REMARKS

Claims 1 through 8 are pending in this Application. In the Office Action dated November 18, 2004, the following rejections were again imposed:

1. **Claims 1 through 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al.;**
2. **Claim 7 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al. and Danziger et al.;**
3. **Claim 8 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al. and Eggleton et al.**

Each of the above rejections is traversed.

In the responsive Amendment submitted on September 30, 2004, it was argued that independent claim 1 is directed to a optical transmission system comprising a dispersion compensating system. That dispersion compensating system compensates for both of chromatic dispersion and dispersion slope. However, the primary reference to Ishakawa et al. neither discloses nor suggests the concept of forming an optical transmission system comprising a dispersion compensating system which compensates for both of chromatic dispersion and **dispersion slope**. In fact, the notion of providing a dispersion compensating system for compensating **dispersion slope** is alien to Ishakawa et al. It was also argued that the secondary references to Ngo et al., Danziger et al. and Eggleton et al. do not cure the argued deficiencies of Ishakawa et al.

In the Office Action of November 18, 2004, the Examiner indicated that a dispersion compensating system for compensating both chromatic dispersion and dispersion slope in the optical line is disclosed by Ishakawa et al. at column 20, lines 61 through 63. Applicants find no mention of a **dispersion slope** in the indicated part of Ishakawa et al. Rejections under 35

U.S.C. § 103, of course, must be predicated upon facts. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Certainly, the Examiner is obliged to identify specifically wherein an applied reference is perceived to disclose each feature of the claimed invention, as well as identify a factual basis for the requisite motivation. *Smiths Industries Medical System v. Vital Signs Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). Again, Ishakawa et al. neither disclose nor suggest the concept of forming an optical transmission system comprising a dispersion compensating system which compensates for both of chromatic dispersion **and dispersion slope**.

In the ultimate sentence of the paragraph bridging pages 5 and 6 of the November 18, 2004 Office Action, the Examiner asserts that Ishakawa et al. disclose "... that chromatic dispersion is the amount of dispersion at a wavelength as defined by the inherent dispersion slope of an optical fiber transmission line" referring to column 20 of Ishakawa et al. lines 5 through 10. Applicants respectfully submit that the Examiner's statement evinces a misunderstanding of "dispersion slope". For the convenience of the Examiner, Applicants submit herewith, as Exhibit A, a copy of "Fiber Optics Standard Dictionary", page 112, which underscores the inaccuracy of the Examiner's above quoted statement.

Applicants again stress that Ishakawa et al. do not mention anything about "dispersion slope" and, hence, Ishakawa et al. neither disclose nor suggest the concept of forming an optical transmission system comprising a dispersion compensating system which compensates for both chromatic dispersion and **dispersion slope**.

Moreover, as previously pointed out, none of the secondary references cure the argued deficiencies of Ishakawa et al. Accordingly, even **if** all of the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation


has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 1 through 6 under 35 U.S.C. § 103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al., the imposed rejection of claim 7 under 35 U.S.C. § 103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al. and Danziger et al., and the imposed rejection of claim 8 under 35 U.S.C. § 103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al. and Eggleton et al. are not factually or legally viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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